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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/557,252	04/24/2000	Justin Page	PAGE-001	8465
35557 7590 04/28/2009 CHRIS A. CASEIRO VERRILL DANA, LLP ONE PORTLAND SQUARE PORTLAND, ME 04112-0586				
EXAMINER				
LE, MICHAEL				
ART UNIT		PAPER NUMBER		
2163				
MAIL DATE		DELIVERY MODE		
04/28/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/557,252

Applicant(s)

PAGE, JUSTIN

Examiner

MICHAEL LE

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 19-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date: \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 9, 2009 has been entered.

### ***Summary and Status of Claims***

1. This Office Action is in response to Applicant's reply filed February 9, 2009.
2. Claims 19-36 are pending.
3. Claims 19-36 are rejected under 35 U.S.C. 112, first paragraph.
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Specification***

5. The amendment filed February 9, 2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:  
  
6. Both paragraphs submitted by Applicant for addition to the Summary section of the Specification. Consequently, the amendment to the Specification will not be entered.

7. Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

8. **Claims 19-36 are rejected under 35 U.S.C. 112, first paragraph**, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

9. In particular, independent claim 19, as amended, recites "wherein the persistently scanning is performed without notifying the subject of the scanning identity information of the one or more individuals" in limitation (b) and "to ensure that the one or more databases scanned cannot identify the specific target of the scanning" in limitation (c). Independent claim 26 recites similar limitations. These limitations are not described in the specification. In fact, these limitations are not mentioned at all. Applicant's response does not indicate where support for these limitations can be found. In reviewing the most recent amendment to the Specification filed on July 29, 2002, no mention or implication of these limitations can be found. It is unclear how Applicant derived the amendments from the current state of the Specification. At best, the Specification describes accessing the one or more other databases through a secure internet channel. Spec Amendment at pg. 1. However, this does not describe in any way the amended limitations repeated above. It also does not apply the possibility of these features.

10. Claims depending from 19 and 26 are rejected for the same reasons due to their dependency.

*Response to Arguments*

**Rejection of claims 19-36 under 35 U.S.C. 112, first paragraph**

11. Applicant's arguments in regards to the rejections to claims 19-36 under 35 U.S.C. 112, first paragraph, have been fully considered but they are not persuasive. Applicant contends that the limitations mentioned in the rejection above are supported in several location including: (1) original claim 2, (2) original figure 1, (3) claim 2 of the 2002 amendment<sup>1</sup>, and (4) claim 4 of the 2002 amendment. The Examiner respectfully disagrees.

12. Applicant's reliance on claims 2 and 4 of the 2002 amendment is unpersuasive. Amendments to the claims must have support in the application as originally filed. Since claims 2 and 4 are from the amendment filed in 2002, they are not adequate as support for claim amendments.

13. In regards to original claim 2, the claim recites "[a]s regards personal privacy, an 'Agent' (also known as a 'spider', 'Robot', or 'Bot'), that is, a computer program that persistently, 'does your bidding for you.'" By searching multiple databases where privacy is commonly overlooked. (n.b. No claim is made to the 'Agent' model per se, but rather its use to protect personal privacy and defend personal privacy)." There is nothing in this claim that describes persistently scanning without notifying the subject of the scanning identity information of the one or more individuals or ensuring that other databases scanned cannot identify the specific target of the scanning as recited in claims 19 and 26. Applicant's reliance on original claim 2 seems to be focused on the recitation of "protect personal privacy and defend personal privacy" in the claim. However, this

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<sup>1</sup> Actually filed 7/29/2002 and not 7/23/2002 as indicated by Applicant.

recitation alone is insufficient to support the limitations at issue. Moreover, this part of original claim 2 can easily be interpreted to mean protecting a user's private information, which although is the purpose of the instant invention, is still insufficient as support for the specific features in claims 19 and 26.

14. In regards to figure 1, Applicant seems to rely on reference character 1, which identifies a box that states "Privacy oriented metadata access and 1 collection device." Again, the simple recitation of "privacy oriented metadata access" is insufficient to support the limitations at issue.

15. The Examiner is not persuaded that the cited portions provided by Applicant fully support the limitations at issue. A second review of the Application as originally filed still does not provide sufficient support for the limitations at issue. For at least these reasons, the Examiner maintains the rejection under 35 U.S.C. 112, 1st paragraph.

16. Consequently, the rejection to claims 19-36 under 35 U.S.C. 112, first paragraph is maintained.

### ***Conclusion***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Le whose telephone number is 571-272-7970. The examiner can normally be reached on Mon-Thurs : 9:30am-6pm, Fri: 8am-4:30pm.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael Le/  
Examiner, Art Unit 2163

/Hung T Vy/  
Primary Examiner, Art Unit 2163